REMARKS

Claims 1-21 are pending in the above-referenced patent application. Claims 1, 8 and 17 are independent.

Applicant has canceled claims 2 and 18.

In a previous office action, the examiner used Ellis to reject claims 1-3, 5 and 8-20 are having been anticipated.

Claims 1, 8 and 17, as amended, recite "receiving an order for pre-recorded audio or pre-recorded video data offered in a broadcast based on a user selection made while viewing the broadcast through a video viewing system," or similar language. Ellis does not disclose or describe at least this quoted claim feature.

Ellis discloses a system in which a program is only recorded in response to a request received through a program guide:

> **[0011] It is therefore an object of the present invention to provide a program guide system that allows users to direct a server to record certain programs that later may be played back to the user on demand. [Ellis, paragraph 0011]**

Ellis only records after a request is received:

> **[0075] Remote media server 24 of FIGS. 2a, 2b, 2c, 2d, and 2e records programs, program guide data, or any suitable combination thereof and supplies either or both to user television equipment 22 in response to requests generated by the program guide. Remote media server 24 may also record program associated data, such as data carried in the vertical blanking interval (VBI) of an analog television channel or in a digital data track on a digital television channel. Examples of program associated data are subtitles, text tracks, music information tracks, additional video formats, additional languages, or other additional data. As used herein, recording and playing back "programming" or "programs" may include, but does not require, recording and playing back program associated data. Remote media server 24 is shown as being located at program guide distribution facility 16, but may be located at a separate distribution facility (e.g., a cable system headend, a broadcast distribution facility, a satellite television distribution facility, or any other suitable type of television distribution facility). [Ellis, paragraph 0075]**

Ellis does not disclose a request for pre-recorded data through, and at the time of, a broadcast:

> **As defined herein, the phrase "recording on-demand" refers to recording a program or program guide data in response to a user's selection of a program for recording. [Ellis, paragraph 00076]**
>
> **[0084] Remote media server 24 records programs and associated program guide data on storage 15 in response to record requests generated by the program guide implemented on interactive program guide television equipment 17. As defined herein, a "record request" is any command, request, message, remote procedure call, object based communication, or any other type of interprocess or**

inter-object based communication that allows the program guide to communicate information on the program that the user wishes to record to the media server. [Ellis, paragraph 0084]

Accordingly, claims 1-3, 5 and 8-20 are not anticipated by Ellis.

In the same previous office action, the examiner used Ellis to reject dependent claims 4, 6, 7 and 21 as having been obvious.

Claims 1, 8 and 17, as amended, recite "receiving an order for pre-recorded audio or pre-recorded video data offered in a broadcast based on a user selection made while viewing the broadcast through a video viewing system," or similar language. Ellis does not teach or suggest at least this quoted claim feature and was discussed above.

As the examiner knows, in determining obviousness, "[t]he claimed invention must be considered as a whole, and the question is whether there is something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination." Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick, 221 USPQ 481, 488 (Fed. Cir. 1984).

Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under Section 103, teachings of references can be combined only if there is some suggestion or incentive to do so. ACS Hospital Systems, Inc. v. Montefiore Hospital, 221 USPQ 929, 933 (Fed. Cir. 1984).

"The critical inquiry is whether 'there is something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination.'" Fromson v. Advance Offset Plate, Inc., 225 USPQ 26, 31 (Fed. Cir. 1985).

"The mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification." In re Gordon, 221 USPQ 1125, 1127 (Fed. Cir. 1984).

Combining Ellis with what was known in the art at the time of the invention produces a system of recording a broadcast after a request is received to record. This is very different from receiving an order for pre-recorded audio or pre-recorded video data offered in a broadcast based on a user selection made while viewing the broadcast through a video viewing system. Accordingly, claims 1, 8 and 17 are not obvious in view of Ellis.

Claims 4, 6, 7 and 21 depend upon, and add further limitations to, claims 1, 8 and 17. Accordingly, claims 4, 6, 7 and 21 are not obvious in view of Ellis.

It is believed that all of the pending claims have been addressed. However, the absence of a reply to a specific rejection, issue or comment does not signify agreement with or concession of that rejection, issue or comment. In addition, because the arguments made above may not be exhaustive, there may be reasons for patentability of any or all pending claims (or other claims) that have not been expressed. Finally, nothing in this paper should be construed as an intent to concede any issue with regard to any claim, except as specifically stated in this paper, and the amendment of any claim does not necessarily signify concession of unpatentability of the claim prior to its amendment.

Respectfully submitted,

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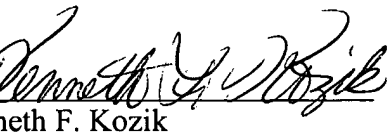

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